

Amendment

Serial No. 09/738,562

Title: METHOD FOR PROVIDING IN TRANSIT AUTHENTICATION, REPAIR AND CUSTOMIZATION OF AUCTIONED GOODS

REMARKS

The Examiner objected to the specification on the grounds that it contained hyperlinks or other browser executable code. Applicant notes that the specification was filed as a paper copy. Accordingly, applicant is mystified how a paper document could contain executable code. Nevertheless, insofar as applicant can understand the objection, applicant has amended the specification to further obscure the references to the eBay and Pinggolf web sites.

Claims 1-13 were pending in the application prior to the Office Action dated 10/06/2004. Claims 14-17 are added by this amendment. Accordingly, claims 1-17 are now pending in the application.

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as obvious considering United States Patent No. 6,115,690 to Wong in light of the Examiner's observations that on-line auction web sites are well-known. Applicant respectfully traverses the rejection.

Wong discloses an integrated business-to-business web commerce and business automation system in which a plurality of individuals associated with a single business entity share access to a web-enabled relational database. The advantages recited in Wong for using a single relational database to run the day-to-day operations of the business include eliminating the duplicate manual entry of data by different departments (e.g. sales, customer service, accounting, purchasing, receiving, shipping) and providing management with ready access to verifiable information. The Web component of the single relational database "provides a window into a 'seamless' end-to-end internal business process." [Column 4, lines 16-18] (emphasis added). Thus, Wong teaches use of

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a Web-enabled database to support the internal data management requirements of, for example, an external sales force (which may include the sale of services such as installation). Nothing in Wong, however, teaches or suggests use of a web-enabled system for selling factory authorized services in the context of an on-line auction, which, by definition is not an internal database management function. Indeed, the business automation system disclosed by Wong is specifically contrasted to a consumer-oriented Web commerce system, such as an on-line auction. [Column 14; lines 15-29].

Accordingly, nothing in Wong discloses or suggests adapting the internal business automation system taught by Wong to the on-line auction environment. Similarly, since nothing inherent in the mere existence of on-line auctions suggests adapting the on-line auction environment to selling factory authorized services for the products being sold in the auction, nothing in the Examiner's reference to the existence of auction web sites such as eBay, uBid, yahoo, etc. provides any motivation for the combination suggested by the Examiner.

It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive in the prior art supporting the combination. In Re Geiger, 815 F.2d, 686, 688 (Fed. Cir. 1987); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984). Use of the inventor's own disclosure as a blueprint for piecing together the prior art to defeat patentability is the essence of impermissible hindsight reconstruction. In Re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). When the patent invention is made by combining known components to achieve a new system, the

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prior art must provide a suggestion, or motivation to make such a combination. Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376 (Fed. Cir. 2001); It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor. Northern Telecom v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1991). Accordingly, since the prior art merely discloses the components of the invention disclosed and claimed in the present application, but not the teaching, suggestion, or incentive to make the combination, the combination suggested by the Examiner is improper and the rejection under 35 U.S.C. § 103 should be withdrawn.

Claims 14-17 are added to further distinguish the present invention from the references of record. Wong teaches an internal database for running the day-to-day operations of a business, which the Examiner notes may include the sale of installation services for the product being sold. Since Wong teaches a database for running a single business entity, nothing in Wong discloses or suggests adding an independent seller of services to the sales transaction as claimed in new claims 14 and 16. Similarly, since Wong teaches use of a web-enabled database to support the primary sales function of a business entity, nothing in Wong discloses or suggests the sale of repair, authentication, or customization services, which are exclusive to the used, secondary sales market.

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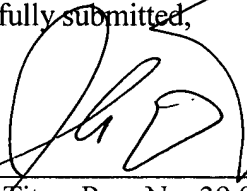
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Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing,
applicants believe that all claims under consideration are in a condition for allowance and
reconsideration of this application is respectfully requested.

Respectfully submitted,

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